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09/366,896	08/04/1999	PAUL NORMAN BURGESS	42430-10030	3637

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Patent Docket Clerk
Jenner & Block, LLC
One IBM Plaza
Chicago, IL 60611

EXAMINER

DEANE JR, WILLIAM J

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/366,896
Filing Date: August 04, 1999
Appellant(s): BURGESS, PAUL NORMAN

MAILED

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Technology Center 2000

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For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 22, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims (see Appeal Brief) do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 – 12 & 19 - 26 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on November 18, 2003. The Final Office Action is produced below.

Claims 1, 5, 9 and 11 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,085,081 (Leskinen).

With respect to claims 1 and 9, Leskinen teaches the claimed device and method as shown at Col. 3, line 22 – Col. 4, line 9, see also the abstract and claim 1. Briefly, Leskinen teaches a method in which a connection is made between a communication terminal and a communication network and that a user ID is used as a temporary ID to identify the communication device and make the connection.

Note that the device is only for outgoing calls (Col. 3, lines 11 – 15 and Col. 4, lines 35 – 39).

With respect to claims 11 and 12, such is inherent from the above.

Therefore, Leskinen teaches the claimed device except explicitly teaching that the device inhibits incoming calls. However, it appears that such is contemplated as there is no discussion of any incoming calls whatsoever in Leskinen, but only discussions of outgoing calls as shown above. Therefore, such would have been obvious to one of ordinary skill in the art that having only a user ID and no telephone number would inhibit incoming calls. In addition, see Response to Arguments below.

Claims 2 - 4, 6 - 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leskinen in view of U.S. Patent No. 5,722,067 (Fougnyes et al.).

With respect to claims 2 - 4 and 6 - 8, Leskinen teaches the claimed device except for assigning a currently assigned telephone number with the communications device for billing using ANI.

Fougnyes et al. teach using ANI for billing purposes to a predetermined or pre-selected number (see Abstract, Summary of the Invention and claims). There is no reason why the pre-selected number could not already be a currently assigned number (e.g. an office or home number). It would have been obvious to one of ordinary skill in the art to have provided the Leskinen device and method ANI for billing purposes to an assigned telephone number, as taught by Fougnyes et al. The user of Leskinen's device must be billed for the out-going calls made using the device. Billing has always been in the form of billing the telephone number used (which does not exist in Leskinen), charging a pre-paid card or credit/debit card or charging a third party telephone number. The claim simply recites billing, e.g., a home/office number, for out-going calls made by the device. Third party billing is old and notoriously well known in the art. See "card owner" information in Leskinen, Col. 6, lines 20 – 34. In addition, note that many companies (e.g., Verizon and AT&T, among others) provide one bill for multiple telephones such as cellular telephones and home telephones.

With respect to claim 3, once a number is associated with a telephone number, it would have been obvious to one of ordinary skill to use the association for maintenance, billing, ... and etc.

With respect to claims 7 and 10, obviously once the account is canceled; the pre-selected number would be reused. With respect to claim 10, note Col. 4, lines 13 – 18. It would have been obvious to have provided the Leskinen device and method with the ability to assign temporary numbers, as taught by Fougnyes et al., in order for the Leskinen device to receive incoming calls.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leskinen in view of Fukuzawa et al.

Leskinen teaches the claimed device except for the temporary assigning of unassigned telephone numbers in which the assigning of temporary numbers is initiated by a phone call. However, Fukuzawa et al. teach such limitations (see Abstract, Summary of Invention and Claim 1). It would have been obvious to one of ordinary skill in the art to have provided the Leskinen device and method with the ability to initiate usage of a temporary number via phone call, as taught by Fukuzawa et al., in order to receive incoming calls. In addition, note Col. 6, lines 53 – 56. A temporary phone number is needed to receive incoming calls.

With respect to claims 19 – 26 such claims would be rejected in a like manner to the claims above. The claims, 19 – 26, are only differentiated by claiming the assigning of a telephone number to a line rather than to a device. However, such would have been obvious to one of ordinary skill in the art in light of the Leskinen reference. With such things as dedicated lines, it would have been obvious to assign a telephone number to a line (e.g. a home/office landline telephone line) just like assigning it to a device (e.g., cellular telephone).

(11) Response to Argument

It should be noted that the examiner gives no patentable weight to Appellant's preamble of claims 1 and 19. First, because there is no assignment of telephone numbers in the body of the claim. Second, because throughout the specification (see also the Summary in Appellant's Appeal brief), Appellant describes assigning a telephone number, but then describes how the disclosed method conserves telephone numbers. If one is assigning telephone numbers how does this method, as disclosed by Appellant, conserve telephone numbers? The examiner therefore looked at Appellant's method as one in which telephone numbers are "omitted" as claimed by Appellant (see step C in Claims 1 and 19), but that a memory stores an equipment identifier that identifies a communication or line based on the equipment identifier (see Appellant's Appeal Brief, page 3, 1st full Paragraph). That is, that no telephone number was truly assigned because it was "omitted" and the use of an identifier was used in place thereof. Note the apparent contradiction on this issue on page 2, lines 13 – 17. First a number is assigned to a communication device or line then however, no number is assigned to the device or line.

Appellant is correct in that the reference, U.S. Patent No. 6,085,081 (Leskinen), does not explicitly disclose assigning telephone numbers or associating a telephone number with the equipment identification. The reference is also silent about receiving any incoming calls. With respect to the former, such is explained above. With respect to the latter argument, the examiner explained in the Final Office Action that it is true that Leskinen does not explicitly teach or disclose inhibiting incoming calls, but such can

be inferred from a fair reading of Leskinen. One teaching of Leskinen is to have a phone that one seldom uses and one that allows a user to switch teleoperators when desired and to be unidentified to a Network. Also note that whatever ID is given such is temporary (Col. 3, lines 5 - 18 and lines 22 - 27). How could one make an incoming call under these conditions? A caller to the user would not know the user's telephone number. Even if the a user gave a caller a number to call- back (which does not appear to be possible) the invention could still be said to inhibit calls. That is, if a caller had somehow gotten a number to the device, he would have to make a call before the user changed the ID or changed teleoperators. Once the change is made by the user other incoming calls would be inhibited. For example, if a user using the Leskinen device misdialed and got a wrong number, the user's number would not show a caller ID at the wrongly called device. Even if a caller ID was shown at the wrongly called device, and a user has the ability to change his ID and teleoperators dynamically, would not this inhibit incoming calls? Therefore, how could someone call the Leskinen device which continuously changes operators and IDs? Which operator/company would handle the incoming call?

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, Appellant argues that Leskinen is silent with respect to conservation of telephone numbers generally and specifically silent with respect to inhibiting incoming calls. With respect to inhibiting incoming calls, such has been discussed above. With respect to conserving telephone numbers, since the user ID is used to make the connection, a telephone number is obviously conserved. Appellant points to Col. 8, lines 59 – 65 to show that the mobile station of Leskinen, acts like a “normal” mobile station. However, from a fair reading of Leskinen, it is clear that it does act as a normal telephone except for incoming calls. That is, one can make normal calls and get other network services, but that does not mean one can receive incoming calls. As discussed above, how could one receive an incoming call under the conditions of Leskinen (e.g. changing the temporary ID and/or teleoperators dynamically)?

Appellant argues that since neither Fougnes nor Fukuzawa supply the missing information, that is, the inhibiting of incoming calls or conserving telephone numbers, no motivation exists. For example, Appellant argues Fukuzawa does not conserve telephone numbers, but admits Fukuzawa uses temporary telephone numbers. Though Fukuzawa may not say the exact words “conserve telephone numbers” it is obvious that temporary telephone numbers conserve such numbers. A temporary telephone number is assigned temporarily and then re-used. Fukuzawa also inhibits incoming calls. Since the number is temporary, if one calls after the temporary number is changed or recycled, they will not be connected. In addition, none of the claims in the instant

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application recite "conservation of telephone numbers via inhibiting incoming calls" in any form. Motivation is clear and proper with respect to the references used.

In summary, it is clear that a fair reading of Leskinen reads on the Appellant's device and method and therefore, the rejections are proper. For the above reasons, it is believed that the rejections should be sustained.

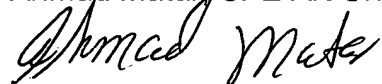
Respectfully submitted,


William J. Deane, Jr.

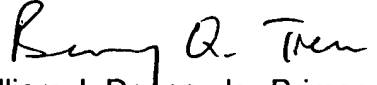

June 23, 2004

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